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No. 1654

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In the

Supreme Court of the United States

OCTOBER TERM, 1969

THE BENDIX CORPORATION and
SELLEW CORPORATION,

Petitioners,

vs.

BALAX, INC. and JOHN M. VAN VLEET,

Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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The Scheffer Press, Inc.—ANdover 3-6850

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The Questions Presented for Review

In order that the first question incorporate the controlling "circumstances of the case", we suggest restatement of the issue to read:

1. When the claim of a Gebrauchsmuster, a German petty patent, incorporates by reference the specification and patent drawings, may the specification and drawings be considered in determining "what was patented . . . in a foreign country" for the purposes of Section 102 of the Patent Statutes?

The second question presented should be revised to read:

2. Is there any sound reason for this Court to review on writ of certiorari the concurring findings of fact of the Trial Court and the Court of Appeals that the meager disclosure in an earlier filed application for a patent on a product was not sufficient disclosure to support method claims sought in a later filed application?

Argument

Question 1 is fully answered in the opinion of the Court of Appeals (Appendix to Petition A4, A10, 164 USPQ 485 at 487 to 490). The Gebrauchsmuster (GM) claims made specific reference to the specification and are meaningless unless read in the light of the specification. For example—Does the GM meet the limitation of the reissue patent in suit that there be a "tapered threaded end portion"? The GM Claim 1 refers to the "threaded cross section (b, c, d)". The claim does not say tapered, but a glance at the drawing shows that portion marked *d* is indeed a tapered threaded end portion and the specification refers to it as "the conical start *d*" of the thread (See Def. Ex. 200, Exhibit Appendix II, pp. 471, 473, 475).

Claim 2 of the GM calls for the tap of Claim 1, "characterized by the shape, disposition and arrangement reflected by the drawing and the specification". There is no way one can determine what was patented by this claim without referring to the drawing and specification. It is for this reason, no doubt, that the Patent Office, when necessary, obtains complete texts of the specifications of Gebrauchsmuster from the German Patent Office and maintains a file of such copies.*

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* Manual Patent Examining Procedure 901.05(b) provides in part:

> "German Utility Models (Gebrauchsmuster) may be used as references as prior patents, but not as printed publications since the full specifications are not printed effective as of their registration date. When necessary, the Librarian will obtain the complete text of the specification from the German Patent Office. A file of such copies is maintained in the Scientific Library."

The purported conflict of the Court of Appeals opinion with the opinion of the District Court in the *Reeves* case (Petition, p. 8) is non-existent. The Court of Appeals clearly explained the differing results—on differing facts (Appendix to Petition, pages A5 - A7). *Reeves* was dealing with an alleged invention which was not, and could not have been, patented by a GM.

Question 2 was answered by both the District Court and the Court of Appeals, each of which held the method patent invalid because they found it was employed beginning in June of 1956 by customers of Petitioner. No question of public disclosure to or by them was involved. They employed the method in commercial operations and hence there was an invalidating public use of the method, regardless of whether they, or anyone else, characterized the use in terms of the method claims specifically allowed.

The test as to the sufficiency of the disclosure of the original application filed in April of 1956 to support the method claims first sought in 1958 is a simple factual test as to whether that original application contained an adequate disclosure to support each element of the method claims. The District Court and the Court of Appeals each found the original specification wanting (See Appendix to Petition A14 - A17 and A38 - A42). The extensive additions to the original disclosure, which were made when seeking method claims in the 1958 application, are underlined in Defendants' Exhibit 430 (Appendix II, pages 660-662).

Petitioners have delayed the present application until 125 days after the Judgment of the Court of Appeals. Judgment of the Court of Appeals was entered on January 30, 1970, and rehearing was denied on March 9, 1970. The Petition should be denied promptly, before the sum-

mer recess, in order that: (a) Respondent may without delay pursue the remanded anti-trust charges of the counterclaim, and (b) Petitioners' licensees will not have to continue paying—and passing on to the public—thousands of dollars each month on licenses on three patents: one of which Petitioner has admitted in this action was invalid on its own prior public use; the second of which was held invalid by both the District Court and the Court of Appeals on prior public use by Petitioners' customers; and the third of which was held invalid by the Court of Appeals as shown in a prior German patent (without even reaching questions of invalidity on German publications showing the same structure, and on prior sales in the United States of the same structure by Detroit Tap and Pratt & Whitney in 1950).

Respectfully submitted,

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Certificate Of Service

I hereby certify that on this 9th day of June, 1970, copies of this Brief in Opposition to Petition For Writ of Certiorari were mailed, postage prepaid, to Howard T. Markey, Daniel C. McEachran and Parker, Carter & Markey, 8 South Michigan Avenue, Chicago, Illinois 60603. I further certify that all parties required to be served have been served.

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Counsel for Respondent

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